

REMARKS

Status of the Claims

Claims 1 and 3-27 are pending in this application.

Claims 1-27 are rejected.

Claims 1, 3, 13, 15, 17 and 20 are objected to.

Claim 2 has been canceled, without prejudice.

Claim 1 has been amended. Support for these amendments can be found throughout the specification, claims, and drawings, as originally filed.

Specification Objections

The Office Action objected to the specification because of some informalities as presented in paragraphs 6a-6e of the Office Action. Applicant has reviewed these informalities and has corrected the specification in a manner consistent with what the Examiner suggested in the Office Action. Applicant believes that the amendments to the specification correcting informalities introduce no new matter; therefore, Applicant respectfully requests entry of the amendments.

With regard to the specification objection set forth in paragraph 6(f) of the Office Action, it was indicated that the use of reference characters 4, 1a, 1a' and 1b is unclear and indefinite. With regard to reference character 4, Applicant respectfully submits an amendment to paragraph 15 clarifies that element 4 is not a "light conducting element," but rather is now called a "conducting element." Applicant believes that this amendment to the specification resolves any issues with respect to reference numeral 4. With regard to reference numerals 1a, 1a' and 1b Applicant submits that each of the light conducting elements described in the specification are different variations and therefore,

warrant their own individual reference numeral as opposed to having the same reference numeral throughout the specification. Applicant believes that these deferring variations of the light conducting element are necessary because embodiments of the invention require that the rays of light reflected off of the light conducting surfaces 1a, 1a' and 1b may have different spatial distribution for embodiments where the LED's are stacked, such as those embodiments shown in Fig. 3, Fig. 4 and Fig. 5. Additionally, with regard to reference numeral 1b, the Applicant submits that the light conducting element as shown in Fig. 6 further includes a cooling member 10, 10b therefore, it also necessary to have the further reference numeral designation of 1b for light conducting elements that have a cooling member. Applicant respectfully requests removal of the objection with regard to the use of reference numerals for 1a, 1a' and 4.

Drawing Objections

The Office Action rejected the drawings because they fail to show every feature of the invention specified in the claims, namely the drawings do not show the housing and light disk features as presented in the claims. Applicant respectfully submits a new Fig. 1 and Fig. 3 which schematically shows the housing 20 and light disk 22 feature. Additionally, Applicant has amended paragraphs 15 and 16 of the specification to add in the reference numerals for the housing and light disk. The new drawing figure does not add in any new matter since the original claims as well as the specification did in fact disclose the housing and light disk. Applicant respectfully requests entry of new Fig. 1 and Fig. 3.

The Office Action further objected to the drawings because they did not include a "light-conducting element 1b" which was described in the specification. Applicant

submits a new Fig. 6 which includes a reference numeral directed to the light conducting element 1b. Applicant submits that support for this drawing change can be found in the detailed description, therefore, the new drawing does not add any new matter. As such Applicant respectfully requests entry of new Fig. 6

The Office Action also objected to the drawings because the detailed description section of the specification made reference to light conducting element 1a' which was not shown in Fig. 4. Applicant respectfully submits a new Fig. 4 which includes the reference numeral 1a'. Applicant submits that this newly submitted Fig. 4 does not add any new matter to the application since support for this drawing amendment can be found in the specification as originally filed. Applicant respectfully requests entry of new Fig. 4.

The Office Action also objected to the drawings because reference characters 1a, 1a', 1b and 4 have been used to designate the light conducting element. Applicant respectfully traverses this objection to the drawing. With regard to reference character 4 Applicant has reviewed the specification and drawings and respectfully submits a new Fig. 5 which eliminates reference character 4. Applicant has chosen to do this since it is believed that reference character 4 has no support in the specification and was erroneously included in the original drawing. Applicant respectfully requests entry of new Fig. 5. With regard to the reference characters 1a, 1a', 1b Applicant submits that 37 C.F.R 1.84(p)(4) specifies that the same reference character must never be used to designate different parts. Applicant submits that in each of the figures of the application the light conducting element is not necessarily the same. For example, reference character 1a is used to designate a light conducting element that has an underside 7 having a reflective surface 8 and an annular surface having a set configuration to reflect

rays of light L' that have a given spatial distribution. To the contrary light conducting element 1a' has reflective surfaces 8' that are spaced to reflect rays of light L that are spaced differently from the rays of light L' emitted from light conducting element 1a. Thus Applicant submits that light conducting element 1a and light conducting element 1a' are designating two different parts additionally light conducting element 1b which is shown in Fig. 6 is also different from light conducting elements 1a and 1a' because light conducting element 1b further includes a cooling member 10, 10b; therefore, Applicant submits that the use of reference character 1b is also correct since the light conducting element 1b is in fact different from the light conducting element 1a and light conducting element 1a'. Applicant respectfully requests removal of the objection to the drawings and further requests entry of the attached new replacement drawings.

Claim Objections

The Office Action objected to claim 1 stating that "[i]t is unclear what the light disk is – the Examiner assumes that this is referring to a lens or enclosure for the lamp." Applicant has submitted with this Office Action replacement drawing sheets which include drawing amendments for Fig. 1 and Fig. 3. Applicant points out that element 22 on Fig. 1 and Fig. 3 is the light disk and it is now clear that the light disk is an enclosure for the lamp. Applicant believes that there is no longer a need to amend claim 1.

The Office Action objected to claims 3 and 15 indicating that the term "reflector" is vague and indefinite. Applicant has reviewed the objections to claims 3 and 15 and has amended claims 3 and 15 and any subsequent dependant claims to recite "annular reflector".

Claim 13 was objected to because of use of the word "preferably." Applicant has reviewed claim 13 and has amended claim 13 so that the word "preferably" has been removed. Applicant respectfully requests removal of the objection to claim 13.

The Office Action further objected to claim 17 suggesting that it should be amended to read "the reflector comprises a light passage opening to emit the rays of light to the light-conducting element." Applicant has reviewed claim 17 and has amended claim 17 to include the language suggested by the Examiner. Additionally the Office Action pointed out that there were issues with respect to the term "light-conducting element" being used interchangeably with other terms. Applicant submits that claim 17 is dependent upon claim 16 which is dependent upon claim 15. Dependent claim 15 introduces the light conducting element which is different from an annular reflector. Therefore, Applicant maintains that there is no confusion of terms and there is proper antecedent basis for the use of the terms "light-conducting element." Applicant respectfully requests removal of the objection to claim 17.

The Office Action also objected to claim 20 suggesting that it be written "the light rays from the reflector" or "the light rays reflected by the reflector." Applicant has reviewed claim 20 to read "the light rays from the reflector." Applicant respectfully requests removal of the objection to claim 20.

Rejection of Claims 7-27 Under 35 U.S.C. § 112

Claims 7-27 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention. The Office Action indicated that the terms "light

conducting element” and “reflector” needed to be defined and the language be consistent throughout the specification. Claims 19 and 22 were rejected because the limitation “reflection surfaces” had insufficient antecedent basis. Claim 24 was rejected because the limitation “rear portion” also had insufficient antecedent basis. Applicant has reviewed all of the rejections presented in the Office Action with regard to 35 U.S.C. § 112 and has addressed each of these issues.

With regard to the rejection of claims 7-27 Applicant believes that this rejection has been obviated by amendment. Applicant notes that the term reflector has been amended to recite “annular reflector” and the term light conducting element and annular reflector have been kept separate and are not used interchangeably. Furthermore, Applicant submits that antecedent basis problems that existed for the terms “annular reflector” and “light conducting element” have been addressed. Applicant respectfully requests removal of the rejection of claims 7-27 under 35 U.S.C. § 112.

With regard to the rejection of claims 19 and 22 Applicant has amended claims 19 and 22 to further define two or more reflection surfaces. Applicant believes that these amendments now obviate the rejection of claims 19 and 22. Applicant respectfully requests removal of the rejection.

With regard to the rejection of claim 24 Applicant notes that claim 24 has been amended and the limitation “rear portion” has been deleted. Applicant has amended claim 24 to recite “underside of the reflection part” which Applicant believes addresses the rejection set forth in the Office Action. Applicant respectfully requests removal of the rejection of claim 24.

Rejection of Claims 1-27 Under 35 U.S.C. § 102(b)

Claims 1-27 stand rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 6,447,155 to Kondo et al. (hereafter Kondo). Claim 1 of the present application is the only independent claim and claims 2-27 are dependent either directly upon or indirectly upon claim 1. Therefore, if independent claim 1 is determined to not be anticipated by Kondo then the rejection of dependent claims 2-27 will be overcome. Applicant respectfully submits that claim 1 of the present application has been amended and that amended claim 1 is clearly not anticipated by Kondo. With regard to claim 1 the Office Action stated that:

Kondo teaches a lamp unit/housing [Figure 1: (1)] for a vehicle having two light sources [Figure 2: (11, 21)] that are positioned behind a light disk [Figure 2: (3)] and associated with at least one reflection part [Figure 2: (12-14 and 22)], wherein one of the light sources provided is an LED [Figure 2: (11)] that emits light laterally (inherent) and is surrounded by a reflection part [Figure 2: (12-14); see also Figures 3-5].

With regard to the rejection of claim 1 the Office Action indicated that an LED that emits light laterally is an inherent structure. Applicant respectfully points out that “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).” MPEP 2112 at p. 2100-52. In order to establish inherency extrinsic evidence must make it clear that the missing descriptive matter that is not present in a reference would be recognized by persons of ordinary skill. *In re Robertson*, 169 F3d 743, 745, 49 USPQ2d. 1949, 1950-51 (Fed. Cir. 1999); See also MPEP 2112 at p.2100-52. It is further been stated that in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte*

Levy, 17 USPQ2d. 1461, 1464 (Bd. Pat. App. & Inter. 1990). Taking the above into consideration, the inherency argument made in the present Office Action does not appear to be well supported.

The present Office Action does not provide any basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Therefore, since the inherency argument regarding the light projecting from the LED in a lateral direction is not supported than Applicant submits that the 35 U.S.C. § 102(b) argument with respect to claim 1 is overcome since there is no extrinsic evidence supporting the notion that the language in claim 1 which states “an LED emitting light laterally from said LED” is anticipated by the Kondo patent either explicitly or inherently. Removal of the 35 U.S.C. § 102(b) rejection with respect to claim 1 in view of the Kondo patent is respectfully requested. Additionally currently pending claims 3-27 are all dependent claims that either depend directly or indirectly from independent claim 1. Therefore, Applicant respectfully requests removal of the 35 U.S.C. § 102(b) rejection of these dependent claims since in Applicants view, these claims are allowable by virtue of their dependency.

Applicant further submits that currently amended claim 1 is not anticipated by Kondo. In pertinent part claim 1 states “wherein said at least one reflection part is adjacent too and **surrounds** said LED and has **a height that is less than or equal too said LED.**” Claim 1 [emphasis added]. Applicant points out that Kondo fails to anticipate claim 1 because the reflection part of Kondo is not adjacent too and surrounds the LED, nor is the height of the reflection part equal too or less than the height of the LED. There is nothing in the text of Kondo that discloses the reflection part

14 being the height of equal or lesser height than the LED. Furthermore, the position of the reflecting portion 14 is not adjacent the LED, but rather is positioned on a plane that is substantially juxtaposed to the top of the LED. For this reason Applicant maintains that claim 1 as currently amended is not anticipated by Kondo; therefore, Applicant respectfully requests removal of the 35 U.S.C. § 102(b) rejection of claim 1. Additionally, claims 3-27 are all dependent claims that either depend directly or indirectly from independently claim 1. Therefore, these claims will not be anticipated by Kondo by virtue of their dependencies. As such Applicant respectfully requests removal of the rejection of dependent claims 3-27 and allowance thereof.

Applicant also maintains that independent claim 1 would not be rendered obvious by the Kondo patent. The specification of Kondo does not teach or suggest an LED that emits light laterally, which was indicated by the Office Action as being inherent to the prior art. Also there is nothing in the specification of Kondo that teaches or suggest the reflector part being adjacent to and surrounding the LED. Kondo also does not teach or suggest the reflector part having an equal to or lesser height than the LED. Therefore, Applicant maintains that currently amended claim 1 could also not be rendered obvious by Kondo since this reference does not provide any motivation to combine with other references. As such Applicant does not believe that the Kondo patent would not affect the patentability of claims 1 and 3-27 from the standpoint of obviousness.

Rejection of Claims 24-27 Under 35 U.S.C. § 103(a)

Claims 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,447,155 to Kondo et al. (hereafter Kondo) in view of U.S. Patent No. 5,136,483 to Schöniger et al. (hereafter Schöniger). Claims 26-27 were rejected

under 35 U.S.C. § 103(a) as being rendered obvious by Kondo. Applicant points out that claims 24-25 are dependent claims which ultimately depend from claim 1 of the present application; therefore, the combination of Kondo in view of Schöniger must render claim 1 of the present application obvious.

Applicant submits that currently amended claim 1 is not rendered obvious by Kondo in view of Schöniger. In pertinent part claim 1 states “wherein said at least one reflection part is adjacent too and **surrounds** said LED and has a **height that is less than or equal too said LED.**” Claim 1 [emphasis added]. Nowhere does the specification of Kondo teach or suggest an LED that has a reflection part that has a height that is equal too or less than the height of the LED. Fig. 2 of Kondo shows a reflection part 14 that is positioned on a plane that is substantially juxtaposed to the top of the LED 11. Thus the reflection part 14 does not surround the LED and does not appear to have a height that is less than or equal to that of the LED. Nowhere does the specification of Kondo teach or suggest this limitation. Additionally the Schöniger patent discloses a reflecting layer 16 in Fig. 2 and Fig. 3. However, as shown in Fig. 2 and Fig. 3 the reflecting part 16 has a height that is greater than the height of the LED 14 and the specification of Schöniger does not teach or suggest the height of the reflector being less than or equal to the height of the LED. Therefore, the Schöniger patent in combination with Kondo fails to render the proposed combination of elements of claim 1 obvious. Since Kondo in view of Schöniger fails to teach or suggest the combination of elements set forth in claim 1 Applicant respectfully requests removal of the rejection of claims 24-25. As stated above claims 24-25 are dependent upon claim 1 and they include the patentable combination of the elements set forth in claim 1; therefore, dependent claims 24 and 25 cannot be rendered obvious since as discussed above

claim 1 has not been rendered obvious by the combination of Kondo in view of Schöniger. Therefore Applicant respectfully requests removal of the rejection of dependent claims 24 and 25 and allowance thereof.

Applicant also submits that the combination of Kondo in view of Schöniger are not properly combinable to render claim 1 as a whole obvious. Kondo fails to render obvious the portion of claim 1 which states “an LED emitting light laterally from said LED.” There is nothing in the specification of Kondo that teaches or suggests this limitation. The figures in Kondo only show the light rays from the LED 10 emitting from the LED in a longitudinal direction. For example Fig. 3 of Kondo shows the light ray emitting from the LED 11 towards a deflecting surface 13 where the light rays are then directing toward a second reflecting surface 16. See Col. 4, Lines 23-32 and Fig. 3. The Schöniger patent also does not teach or suggest this limitation. The LEDs are shown in the Schöniger patent at label 14. Fig. 3 of Schöniger shows the rays of light from the LEDs 14 extending in a non-lateral direction towards a reflecting surface 16. There is nothing in the specification that teaches or suggests the light rays being emitted laterally from the LED. Therefore, the proposed combination of Kondo in view of Schöniger does not render obvious the combination of elements presented in claim 1.

With regard to the rejection of claims 26-27 Applicant points out that these claims are ultimately dependent upon claim 1. As discussed above the Kondo patent does not render claim 1 of the present application obvious. Therefore, since claims 26 and 27 are dependent upon claim 1 and include all of the limitations of claim 1, Kondo likewise does not render claims 26 and 27 obvious since the patent fails to teach or suggest a reflection part that surrounds the LED and has a height that is equal to or less than the LED, nor does the Kondo patent contain any basis of fact or technical reasoning to render the portion of claims 1 which states “an LED emitting light laterally from said

LED" as being an obvious variation of what is taught by Kondo. Therefore, since Kondo clearly does not render claim 1 of the present application obvious, Applicant respectfully requests removal of the rejection of dependent claims 26 and 27 by virtue of their dependency upon independent claim 1.

CONCLUSION

It is respectfully submitted that in view of the above amendments and remarks the claims 1 and 3-27, as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

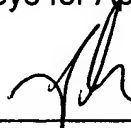
The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 1, Fig. 2, Fig. 5 and Fig. 6. These replacement drawing sheets which include Figs. 1-6, replaces the original drawing sheets that include Figs. 1-6.

Attachment: Replacement Sheets